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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/897,229	07/02/2001	Hanspeter Reust	1177-001A	9023

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EXAMINER

YU, GINA C

ART UNIT

PAPER NUMBER

1617

DATE MAILED: 06/20/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/897,229

Applicant(s)

REUST, HANSPETER

Examiner

Gina C. Yu

Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on February 8, 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5,7-12,14 and 17-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5,7-12,14 and 17-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Receipt is acknowledged of Amendment filed on February 18, 2002.

Claims 1-5, 7-12, 14, and 18-21 are pending. Claim rejections under 35 U.S.C. § 112 are withdrawn in part in view of claim amendments and applicants' remarks. Rejections under 35 U.S.C. § 103 are maintained for reasons of record as indicated in the previous office action dated November 18, 2001. New rejections are made in view of claim amendments by applicants.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 18 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 18 is vague because it is not clear whether "about 0.1% to about 0.7 % wt. Imidazoliny l urea" is a part of the alternative limitation or a required limitation of the claim.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

1. Claims 1-5, 7, 8, 10-12, 14, 17, 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Phillips et al. (U.S. Pat. No. 5,580,491) ("Phillips") in view of Costa et al. (U.S. Pat. No. 6,126,953) ("Costa") and Boothe et al. (U.S. Pat. No. 4,764,365) ("Boothe").

Phillips teaches in Example 5 a method of preparing whey-containing shaving cream composition which comprises admixing a microfiltered whey protein solution containing 5% of solids, ethanol and oil, and heating the mixture to 74 °C for 10 minutes at 2500 psi, and then cooling to 25 °C. See instant claims 1 and 3. Examiner views that the microfiltered whey protein isolation aqueous solution is a mixture of whey powder in a liquid carrier. The reference teaches of the mixture stored for 30 days before formulating into a shaving cream. See instant claim 14. Examiner also views that although the reference does not mention whether distilled or deionized water, given the teaching of using water in the whey solution for the use of food or cosmetic use in the reference, a skilled worker would have obviously used either type of purified water in order to eliminate the possibility of contamination. See instant claims 5 and 10. The reference lacks the teaching of heating the mixture between about 50 °C and its boiling point for 20-60 minutes as instant claims 7 and 8 require, however, examiner views that, given the teaching of heating the mixture at 74°C for 10 minutes, a skilled worker would have known to vary the heating temperature and time. The reference also lacks the teaching of liquid whey as in instant claim 19, however, examiner views that employing liquid whey to mix with whey powder would have been obvious to a skilled worker because of the expectation to produce a product with higher concentration of whey proteins. The reference teaches that cosmetic additives, including antimicrobial actives, may be added to the composition in conventional way, while it is silent as to the specific types of the additives. See col. 2, line 62 - col. 3, line 7.

Costa teaches various personal care compositions including body lotions, shaving creams, and shampoos. See col. 2, line 15 – col. 3, line 54. The reference teaches the preservatives, including methyl, ethyl, propyl, and butyl parabens, EDTA, and imidazolidinyl urea, may be added to the water phase of the compositions in the amount of 0.2 – 2.5 %. See col. 25, lines 8 – 12. Although the reference does not teach the specific amount of the each preservative, examiner takes the position that a skilled worker would have discovered the optimum range of each amount by routine experiments. The reference lacks the teaching of citric acid.

Boothe teaches various personal care compositions including shaving creams and bath composition. See abstract. Example 1 in the reference teaches a method of preparing liquid soap which comprises adding citric acid after mixing the ingredients, heating and cooling the mixture, to adjust the pH of the solution. See col. 4, lines 17 – 61. The reference teaches to add a cationic polymer during the cooling stage, after the first stage when the mixture reaches to 50 °C, and then further cool the mixture to 45 °C before adding the citric acid. Although the reference lacks the teaching of the method steps of instant claims 11 and 12, examiner views that a skilled worker in the art would have known to add the additives in the solution either before or after the heating stage in order to avoid flashing off due to the high temperature.

Given the general teaching of adding cosmetic additives in the process of making cosmetic compositions containing whey in Phillips, it would have been obvious to one of ordinary skill in the art at the time the invention was made to

have to look prior art such as Costa for specific types of the additives. The skilled worker would have been further motivated to employ citric acid to adjust the pH of the composition, as taught by Boothe.

2. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Phillips, Costa, and Boothe as applied to claims 1-5, 7, 8, 10-12, 14, 17, 18 and 19 above, and further in view of Japanese Patent 58192811 ("811").

The combined references, discussed above, lack the specific method steps of instant claims 9.

'811 abstract teaches method of preparing cosmetic composition from whey, which comprises heating whey at 30-50 °C under vacuum to remove the odorous constituents. See abstract.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the method of the combined references by reducing the pressure during the heating process, as taught by '811, because of the expectation of successfully removing odorous constituents from whey.

3. Claims 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hunting (Poucher's Perfumes, Cosmetics and Soaps, 1993) and Rau (US 6121215) in view of Staples (EP 0046326 A2) and McCrea et al. (US 5292530) ("McCrea").

Hunting generally teaches process of making bath powders by mixing sodium carbonate or sodium bicarbonate (in case of effervescent bath powders) with additives. See pages 129 – 130. While teaching powdered bubble bath

formula, Hunting also suggests replacing the sodium carbonate with more emollient materials to produce more elegant products.

Rau teaches foaming effervescent bath compositions such as bath powder. The general formula comprises effervescent component such as sodium bicarbonate, anhydrous foaming surfactant, and additives such as humectants or emollients. See col. 5, lines 9 – 15. See also col. 2, lines 23 – 42. The reference further teaches silica may be added to the product to “help assure the proper density.” See col. 6, lines 14 – 31. See instant claim 20. While the reference does not teach whey powder, it teaches that ‘surfactant blends that generate sufficient foam are also conceivable’.

Hunting and Rau fail to teach whey powder and preservative added in the bath powder.

Staples teaches the use of whey proteins in cosmetic applications including dusting powders, bath preparations, and soaps. See p. 15, lines 1-19. The reference teaches that whey can be added as powders, and that a preservation agent such as parabens may be used to keep the formulations from bacterial contamination. See p. 17, lines 1 – 23. While the reference fails to teach the weight range of the whey powder claimed in the instant application, it does mention that a skilled artisan can easily determine the variance. See p. 16, lines 1 – 20. Staples further teaches that whey product renders cleansing and softening of the skin, “smooth after-feel, . . . smoothing effect on irritated skin. . . and addition of natural protein to skin.” See p. 15, line 24 – 30; p. 17, bridging paragraph.

Hunting, Rau, and Staples fail to teach the recited components in instant claim 21.

McCrea teaches that PEG-4 dilaurate is a well-known emollient or moisturizers used in topical formulations. See col. 8, lines 1-35.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have to modified the bath powder formulas in Rau by substituting the foaming surfactant with whey powder, as suggested by Staples, because of the expectation of successfully producing effervescent foaming bath powder composition which adds natural protein and soothing effect to the skin. Given the general teaching that the carbonate salt in general bath powder formula can be replaced with more cosmetically effective components to produce more elegant products, the skilled artisan would have been motivated to increase the weight percentage of the whey powder which has known cosmetic benefits, as taught in Staples and Phillips.

It would also have been obvious to the skilled artisan to substitute the emollient component taught in Rau with another that is conventionally used in topical formulation, as evidenced by McCrea. The fact that applicants refer PEG-4 dilaurate as a 'preservative' does not change the emolliency property of the component and its known use in cosmetics.

Nothing nonobvious or unexpected is seen in combining components well known in the art. See MPEP § 718.02.

Respons to Arguments

Applicant's arguments filed February 8, 2002 have been fully considered but they are not persuasive.

Applicants assert that the invention in Phillips differs from the present invention, as the prior art employs a microfiltered whey solution instead of solid whey powder. However, Philip does teach that "the whey protein isolate of concentrate component is generally in the form of solids which must be rehydrated and dissolved in the water to form an aqueous solution present in the composition." See col. 2, lines 39 – 45. In view of this teaching, examiner takes the position that making whey solution from whey powder would have been obvious to a skilled artisan.

Applicants also assert that the prior contains the components not recited in the instant claims. It must be noted that the present claims recite "liquid carrier" which does not exclude the presence of ethanol or oil. While applicants argue that the prior art does not teach a "premix" composition, examiner views that that the process of making a final composition as disclosed in Phillips obviously includes the process of making a premix composition.

For example, in Example 5, the process includes making a whey protein mixture that is to be stored for 30 days before blended with other material to form a final product. While Philips does not refer this whey protein mixture as "a premix", there seems to be no unobvious distinction between the process of the prior art and the instant invention.

In response to applicant's arguments against the references Costa, Boothe, and Japanese abstract ('811) individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In this case, applicants argue that Costa and Boothe do not deal with any whey-containing cosmetic and therefore do not render any motivation to combine the teachings with the teaching of Phillips. Examiner respectfully disagrees, as the references are cited to show the obviousness of employing the conventional ingredients well known in the art.

Applicants further assert that the Japanese abstract of JP58192811A is not related to the premix prepared from dry whey powder. The abstract is not cited to show the anticipation of the instant invention but to show the obviousness of heating whey composition under vacuum condition in order to remove malodorous components.

Conclusion

No claims are allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 703-308-3951.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Minna Moezie can be reached on 703-308-4612. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234.

Gina C. Yu
Patent Examiner
June 11, 2002


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